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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,124	01/28/2004	Jane Hirsh	73690.000140	2103

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EXAMINER	
WESTERBERG, NISSA M	

ART UNIT	PAPER NUMBER
1618	

MAIL DATE	DELIVERY MODE
12/02/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/766,124	HIRSH ET AL.	
	Examiner	Art Unit	
	Nissa M. Westerberg	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 September 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 - 4, 11, 12, 15 - 27, 29 - 34* is/are pending in the application.

4a) Of the above claim(s) *11,16,23,25,26,32 and 33* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 - 4, 12, 15, 17 - 22, 24, 27, 29 - 31, 34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Request for Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 1, 2008 has been entered.

2. Applicants' arguments, filed July 1, 2008, have been fully considered but they are not deemed to be fully persuasive. The following rejections and/or objections constitute the complete set presently being applied to the instant application.

Election/Restrictions

3. Newly submitted claim 32 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the originally presented multiparticulate compositions did not claim the presence of an extended release coating in addition to the enteric coating. The species are independent or distinct because claims to the different species recite the mutually exclusive

characteristics of such species. In addition, these species are not obvious variants of each other based on the current record and there is a serious search and examination burden at least because the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries).

4. Newly submitted claim 33 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 33 is directed to a method of making a distinct product from that claimed by Applicant in the product and method of using claims previously examined. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the method of making can be used to make multiparticulate milnacipran compositions that contains an impregnating agent which was added after the milnacipran complex was formed. The compositions of specifically exclude an impregnating agent from being present in the particles.

5. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 32 and 33 are withdrawn from

consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Applicant has requested that all of the obviousness-type double patenting rejection be held in abeyance as they may be overcome by the filing of a terminal disclaimer once the claims have been agreed to be otherwise allowable.

8. Claim 28 was provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 27 of copending Application No. 11192697 in view of Eichman and Paillard. This rejection is MAINTAINED for the reasons of record set forth in the Office Action mailed April 2, 2008.

9. Claims 1, 8, 13, 15, 20 – 22 and 24 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 9, 12 and 16 – 18 of copending Application No. 10/690872 in view of Eichman and Paillard. This rejection is MAINTAINED for the reasons of record set forth in the Office Action mailed April 2, 2008.

10. Claim 27 was provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 24 of copending Application No. 10/690947 in view of Eichman and Paillard. This rejection is MAINTAINED for the reasons of record set forth in the Office Action mailed April 2, 2008.

11. Claims 1, 8, 15, 17, 18 and 20 – 22 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 5, 9, 12 and 15 – 17 of copending Application No. 10/691936 in view of Eichman and Paillard. This rejection is MAINTAINED for the reasons of record set forth in the Office Action mailed April 2, 2008.

12. Claims 1, 8, 10, 15, 20, 21 and 24 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 9, 11, 14 – 16, 18 and 19 of copending Application No. 11/192885 in view of Eichman and Paillard. This rejection is MAINTAINED for the reasons of record set forth in the Office Action mailed April 2, 2008.

Claim Rejections - 35 USC § 112 – 1st Paragraph

13. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

14. Claims 1 – 4, 12, 15 17 – 22, 24, 27, 29 – 31 and 34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is written description rejection. The claims contain the limitation "the particles lack an impregnating agent". In ¶ [0056] of the PGPub of the instant application, several solvating agents exemplified by Raghunathan (US 4,221,778) are listed. At the end of this paragraph, solvating agents are equated with impregnating agents. The exemplified compounds are polyethylene glycol, propylene glycol, glycerin, mannitol, lactose and methylcellulose. Applicant has not provided any other definition of what impregnating agents are. The listed compounds are diverse in structure, including polymers (methylcellulose and polyethylene glycol), monomers (propylene glycol), a monosaccharide (mannitol), a disaccharide (lactose) and a sugar alcohol (glycerin). Therefore, the term "impregnating agents" does not meet the written description provision of 35 USC § 112, first paragraph, due to lacking chemical structural information for what they are and the exemplified impregnating agent structures are highly variant and encompass a myriad of possibilities. The specification provides insufficient written description to support the full genus of impregnating agents encompassed by the claim, since there is no description of the structural relationship and the function these ingredients play in the composition.

15.

Claim Rejections - 35 USC § 112 – 2nd Paragraph

16. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

17. Claims 2 – 4 and 17 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims contain the limitation "less than about" or "less than approximately". "Less than" is a maxima and all possible values below the recited value are encompassed. "About" or "approximately" indicates a range centered on the recited value. Therefore, what values are included in the range "less than about" or "less than approximately" cannot be determined.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

19. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

20. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

21. Claims 1 – 4, 8, 11, 15, 27, 18 and 27 – 29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Eichman (US 5,980,882). This rejection is MAINTAINED for the reasons of record set forth in the Office Action mailed April 2, 2008 and those set forth below. Due to the amendments to the claims, this rejection is now applied to claims 1 – 4, 12, 15, 17, 18, 27 and 29.

Applicant traverses this rejection on the grounds that the prior art teaches away from the instantly claimed invention by disclosing that an impregnating agent, expressly excluded from the invention, is a necessary component. One of ordinary skill in the art would not have expected to obtain a coated ion-exchange particle that did not peel or crack when exposed to water or biological fluids unless an impregnating agent (also

known as a solvating agent) was used during or after complexation of the drug with the resin. The only way one could not use an impregnating agent but still obtain coated resin particles that did not peel or crack when exposed to water or biological fluids was to use the free base and not the salt form of the drug (as shown in US Patents 4,996,047 and 4,894,239). Contrary to the teachings of the art, the claimed composition does not use an impregnating agent and uses the salt form of the drug but has a stable enteric coating.

These arguments are not found to be persuasive. Eichman discloses that "the complex may also be treated by addition of a solvating or impregnating agent" (emphasis added; col 12, ln 40 – 41). Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). (MPEP 2123). Furthermore, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). **MPEP 2123**. While example 1 of Eichman does contain an impregnating agent, the inclusion of such agents is optional and therefore Eichman does not teach away from the exclusion of impregnating agents.

Additionally, in examining the two cited patents, the Examiner was unable to find any recitation of the use of the free base form of the drug to maintain the integrity of the coating layer. US 4,996,047 discloses that control of the amount of drug loading

eliminates the need for an impregnating agent without rupture of the diffusion barrier (col 2, ln 13 – 23). Salts forms of the drug are also used (col 7, ln 36 – 38). In US 4,894,239, the rupture of the coating layer is preventing by the degree of crosslinking and the amount of drug loading of the resin, allowing for the use of the salt form of the drugs, as the salt forms are normally used in the preparation of the drug-resin complexes (col 1, ln 58 – col 2, ln 9). Applicant is kindly requested to point by column and line number for these documents wherein the use of the free base form of the drug to eliminate peeling and cracking of the diffusion can be found in these documents.

22. Claims 1 – 4, 8, 11, 12, 15, 16, 18, 21, 22, 24 and 27 – 29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Eichman further in view of Paillard et al. (US 6,699,506). This rejection is MAINTAINED for the reasons of record set forth in the Office Action mailed April 2, 2008 and those set forth below. Due to the amendments to the claims, this rejection is now applied to claims 1 – 4, 12, 15, 17, 18, 21, 22, 24, 27 and 29.

Applicant traverses this rejection on the grounds that Paillard does not cure the deficiencies regarding the impregnating agent as Paillard does not even use ion-exchange resins.

This is not found to be persuasive as Eichman discloses the optional inclusion of impregnating agent(s) in the composition and therefore Paillard et al. does not need to cure this deficiency.

23. Claims 19 and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Eichman further in view of Kranzler et al. (US 6,602,911). This rejection is MAINTAINED for the reasons of record set forth in the Office Action mailed April 2, 2008 and those set forth below and is now applied to claims 1 – 4, 12, 15, 17 – 20, 27 and 29.

Applicant traverses this rejection on the grounds that Kranzler does teach the use of ion exchange resins for the delivery of agents such as milnacipran to treat FMS (fibromyalgia syndrome), CFS and pain, but it does so in the context of a depot preparation. Even in view of the other references, Kranzler et al. does not disclose compositions for oral administration. The Examiner has not provided any evidence as to why the skilled artisan would have expected to orally administer Kranzler's composition, which is a depot preparation, to successfully treat FMC, CFS and pain.

These arguments are not found to be persuasive. In independent claim 1, "for oral administration" is a recitation of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the method of using claims (claims 27 and 34), the type of administration (e.g., oral, intravenous, depot) is not specified.

While Kranzler et al. does disclose depot preparations of inhibitors such as milnacipran to treat fibromyalgia (¶ [0061]), other administration routes can also be used. Oral administration is taught along with references to a number of techniques in

which sustained release oral preparations can be made (¶¶ [0051] and [0053]). Thus Kranzler et al. teaches that fibromyalgia can be treated by wither oral or depot administration of the inhibitors.

24. Claims 1 – 4, 12, 15, 17, 18, 27 and 29 – 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eichman as applied to claims 1 – 4, 12, 15, 17, 18, 27 and 29 above, and further in view of Shimizu et al. (US 6,328,994).

Eichman discloses milnacipran-ion exchange resin complexes which are coated with an enteric coating. These particles need not contain an impregnating agent.

Eichman does not provide specific examples of enteric polymers which can be used.

Shimizu et al. discloses a variety of enteric polymers, including cellulose acetate phthalate, hydroxypropylmethyl cellulose phthalate, hydroxymethyl cellulose acetate succinate, and methacrylate polymers such as those sold under the tradename Eudragit® L30D-55 (col 9, ln 9 - 19).

It would have been obvious to one of ordinary skill in the art to use the specific enteric polymers such as cellulose acetate phthalate or methacrylate taught by Shimizu et al. in the multipartiuclate milnacipran formulations of Eichman. The person of ordinary skill in the art would have been motivated to make those modifications and reasonably would have expected success because both Shimizu et al. and Eichman deal with enteric coatings on oral pharmaceutical preparations.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nissa M. Westerberg whose telephone number is (571)270-3532. The examiner can normally be reached on M - F, 8:00 a.m. - 4 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NMW

/Jake M. Vu/
Primary Examiner, Art Unit 1618